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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221542
Party	Defendant GIA S.r.l.
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Submission	Answer and Counterclaim
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Signature	/Keith R. Obert/
Date	01/22/2016
Attachments	AnswerandCounterclaim.pdf(37892 bytes )


Registration Subject to the filing

Registration No	4422203	Registration date	10/22/2013
Registrant	Zidian Import, Inc. 492 McClurg Rd. Boardman, OH 44512 UNITED STATES		

Goods/Services Subject to the filing

Class 033. First Use: 2012/10/02 First Use In Commerce: 2012/11/14  
All goods and services in the class are requested, namely: Wines

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>JOHN ZIDIAN CO., INC. and ZIDIAN IMPORT, INC. Opposers,  -against-  GIA S.R.L., Applicant.</b>	<b>In The Matter Of Application No. 86/432,930 Filed: October 23, 2014 Opposition No.: 91/221,542  For the mark:</b>  
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**ANSWER AND COUNTERCLAIM**

Applicant, Gia S.r.l. (hereafter "Gia" or "Applicant") answers the opposition filed by John Zidian Co., Inc. (hereafter "Zidian Co.") and Zidian Import, Inc. (hereafter "Zidian Import" or collectively "Opposer") as follows:

Opening Statement- Gia denies that Zidian Co. or Zidian Import will be



damaged by the registration of the mark (hereafter "GIA and design"). Gia

admits that Zidian Co. and Zidian Import have filed this opposition, and that the identification of Applicant's mark is correct. Gia lacks sufficient information as to the truth of the remaining allegations of this paragraph and therefore denies same.

As to the numbered paragraphs in the Notice of Opposition, Gia responds as follows:

1. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 1, and therefore denies the same.

2. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 2, and therefore denies the same.

3. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 3, and therefore denies the same.

4. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 4, and therefore denies the same.

5. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 5, and therefore denies the same.

6. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 6, and therefore denies the same.

7. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 7, and therefore denies the same.

8. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 8, and therefore denies the same.

9. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 9, and therefore denies the same.

10. Admitted.

11. Admitted.

12. Gia repeats and realleges each and every answer set forth above in reference to paragraphs 1-11.

13. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 13, and therefore denies the same.

14. Gia lacks sufficient information to form a belief as to the truth of the allegations of Opposition paragraph 14, and therefore denies the same.

15. Denied.

16. Denied.

17. Denied

#### Prayer for Relief

Gia denies that either Zidian Co. or Zidian Import is entitled to any relief whatsoever, and specifically denies each and all of the averments and prayers for relief.

#### **DEFENSES**

In further response to the Notice of Opposition, Gia asserts the following defenses:

18. Zidian Co. and Zidian Import have failed to state a claim upon which

relief can be granted, and in particular, failed to state legally sufficient grounds for sustaining the opposition.

19. Opposer's marks are of insufficient strength to prevent registration of Gia's mark.

20. Gia has used the mark *GIA and design* in the United States prior to any and all filing dates of Opposer's asserted registrations and any and all dates of use alleged by Opposer for Opposer's asserted marks.

### **COUNTERCLAIM**

21. Applicant, GIA S.r.l., believes that it is and will be damaged by U.S. Registration No. 4,422,203 for GIA, and hereby counterclaims to cancel the same.

22. U.S. Registration No. 4,422,203 was granted on October 22, 2013 on the Principal Register for GIA for International Class 33 as purportedly used on or in connection with "wines." The registration claims a date of first use of October 2, 2012, and a date of first use in commerce of November 14, 2012.

23. U.S. Registration No. 4,422,203 resulted from intent-to-use U.S. Appl. Serial No. 77/954,946 filed March 9, 2010.

24. Gia, itself or through its predecessors-in-interest or related companies, has continuously used its *GIA and design* mark in interstate commerce throughout the United States since at least as early as April 1998 in connection with the following goods:

anchovy paste; vegetable pastes used as vegetable-based spreads, namely, hot pepper paste, onion paste and sun dried tomato paste;

garlic paste used as a spread, garlic paste for use as a seasoning;  
vegetable pastes used as seasonings, namely, hot pepper paste,  
onion paste and sun dried tomato paste; pesto

and intends to continue so using its GIA *and design* mark in the future.

25. There is no issue as to priority. Gia's first use of the mark GIA *and design* in the United States is well prior to the March 9, 2010 filing date of Opposer's U.S. Appl. Serial No. 77/954,946 for GIA, which U.S. Registration No. 4,422,203 resulted from, and/or any dates of first use that may be established by Opposer for GIA, and therefore Gia's GIA *and design* mark has priority over Opposer's U.S. Registration No. 4,422,203.

26. Gia has expended considerable effort and spent vast sums in advertising and promoting Gia's goods in connection with its GIA *and design* mark throughout the United States.

27. Through advertising and use of GIA *and design*, Gia has developed an excellent and enviable reputation for its goods advertised and sold under its GIA *and design* mark.

28. Gia's GIA *and design* mark has become and is known to the trade and public as an identification and designation of goods emanating exclusively from Gia, and its mark and accompanying goodwill represent very valuable business assets which belong exclusively to Gia.

29. Gia's GIA *and design* mark is an inherently distinctive and strong mark, which serves to distinguish the source of Gia's goods.

30. As a result of widespread advertising, publicity, promotion and substantial sales of Gia's goods provided under its GIA *and design* mark, the GIA *and design* mark has become well known and famous.

31. Opposer's alleged mark GIA is highly similar to Gia's GIA *and design* mark in sound, appearance and meaning and/or commercial impression.

32. The respective goods of Gia and goods of Opposer's alleged mark GIA are closely related and would travel and be promoted through the same channels of trade, and would be rendered to the same class of customers.

33. Because of the similarity of Gia's GIA *and design* mark and Opposer's alleged GIA mark, customers and potential customers are likely to believe that Opposer's goods offered under GIA are being offered by Gia, or with the approval or consent of Gia or under Gia's guarantee.

34. Because of the similarity of Gia's GIA *and design* mark and Opposer's alleged mark GIA, any use by Opposer of GIA is likely to cause confusion, or to cause mistake or to deceive purchasers as to the source, origin of sponsorship or Opposer's business and goods.

35. The registration of and any use of GIA by Opposer has been without the consent, license or permission of Gia.

36. Upon information and belief, Opposer's continued registration of GIA has been and is with full knowledge of Gia's superior and exclusive rights in GIA *and design*, and is calculated and likely to divert and appropriate to Opposer the goodwill created by Gia.

37. In view of the similarity of Opposer's alleged GIA mark with Gia's GIA *and design* mark, and in further view of the relatedness of the respective goods/services, the use of GIA by Opposer for the goods specified in U.S. Registration No. 4,422,203 subject to this counterclaim is likely to cause confusion, mistake and deception within the meaning of § 2(d) of the Trademark Act of 1946 (15 U.S.C. § 1052(d)) and will result in irreparable damage and injury to Gia.

**RELIEF REQUESTED**

In view of the above, Gia requests that this opposition proceeding be dismissed with prejudice, and that the counterclaim for cancellation of U.S. Registration No. 4,422,203 be sustained, and U.S. Registration No. 4,422,203 be cancelled.

Respectfully submitted,  
GIA S.r.l.

Dated: January 22, 2016

By: /Keith R. Obert/  
Keith R. Obert  
Attorney for Applicant

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## **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **ANSWER  
AND COUNTERCLAIM** was served this 22<sup>nd</sup> day of January 2016, by mailing said copy via first class United States mail, to the following counsel of record:

Edward T. Saadi  
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EdwardSaadi@aol.com

By:           /Keith R. Obert/          

Keith R. Obert